

## **REMARKS/ARGUMENTS**

Applicants respond herein to the Final Office Action of April 2, 2009.

Claims 1-36 were pending in the Application prior to the present Amendment, with Claims 13-33 and 36 being withdrawn from consideration. Applicants amend Claims 1, 8 and 9, cancel Claims 7 and 10 and respectfully request reconsideration of the rejections. Claim 1 was amended to include limitations of the previous Claim 7. Accordingly, the Amendment does not present any new issues and does not require an additional search.

### ***Response to Claim Rejections***

Claims 1-12, 34 and 35 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Kubota (4,989,588) in view of Walz (5,540,702).

Claim 1 recites an endoscopic lithotripsy apparatus having a probe, an ultrasonic vibration source 33 transmitting an ultrasonic vibration when the vibration source 33 is connected to a proximal end of the probe, and a mechanical shock generation source 50, which applies a force to the ultrasonic vibration source when the vibration source 33 is disconnected from the proximal end of the probe. The endoscopic lithotripsy apparatus further includes a switch mechanism to switch between the ultrasonic vibration source and the mechanical shock generation source. The switch includes:

a cylindrical case in which the mechanical shock generation source is disposed in a cylindrical shape and in which the ultrasonic vibration source is disposed inside the mechanical shock generation source and which movably supports the ultrasonic vibration source with respect to the mechanical shock generation source and which includes a screw portion on the outer peripheral surface of the distal end;

a coupling member which is supported by the inner peripheral surface of the distal end of the case and which is connected to the proximal end of the probe; and

a cover member which includes a screw portion screwed onto the screw portion of the distal end of the case and which abuts on the coupling member and which is rotated by the distal end of the case so as to attach/detach the coupling member with respect to the ultrasonic vibration source.

Thus, contrary to the Examiner's statement in the Office Action, the apparatus of Claim 1 does not merely combines an ultrasonic "vibration device and a shockwave generating device in one probe," but it includes a specific structure, i.e., the recited switch mechanism, enabling both the ultrasonic vibration and the mechanical shock to enter one common probe. Further, the Examiner indicated in the Office Action that the invention of Claim 1 is merely a combination of the two devices of the

prior art. However, neither of the two cited references disclose or teach how such combination can be achieved and, moreover, what kind of structure would enable the switch from one device to the other. Thus, at least the limitation of the switch mechanism is not disclosed or even suggested by the cited prior art.

Further, with respect to the independent Claim 34, this claim recites a lithotripsy method which includes the step of “using a switch mechanism to switch between applying the mechanical shock with the mechanical shock generation source and connecting the ultrasonic vibration source to the proximal end of the probe.” This limitation of Claim 34 is not disclosed in the cited prior art.

In conventional methods, when ultrasonic vibrations and mechanical shock are applied to a living tissue through an endoscope, it is necessary to first insert and remove a probe, e.g., the probe disclosed in Kubota, and then to insert and remove an impulse conducting wire, e.g., the wire disclosed in Walz. Contrary to such conventional method, in the method recited in Claim 34 the ultrasonic vibration and the mechanical shock are easily and quickly applied by switching between the ultrasonic vibrations and the mechanical shock as the elongate probe is inserted into the endoscope.

Therefore, Claims 1 and 34 are allowable over the prior art of record. Claims 2-6, 8-9, 11-12 and 35 depend from Claims 1 and 34. Therefore, Claims 2-6, 8-9, 11-12 and 35 are allowable over the cited prior art at least for the same reasons as Claims 1 and 34 and further on their own merits.

Moreover, dependent Claims were rejected in the Office Action over the same prior art as Claims 1 and 34. However, the written rejection does not address the limitations recited in these claims. Such piecemeal examination is discouraged by 37 C.F.R. §1.105 and MPEP §707.07(g). It is requested that any future Office Action indicate allowability of any claim that recites a limitation against which no prior art is cited.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
THROUGH THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
EFS FILING SYSTEM  
ON JULY 2, 2009

Respectfully submitted,



---

MAX MOSKOWITZ  
Registration No.: 30,576  
OSTROLENK, FABER LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700